

**REMARKS**

**Status of the Claims**

Claims 30-47, 61, and 62 are currently pending. All claims were rejected in the Office Action mailed September 9, 2003. Claims 30, 40, 42, 44, 46, 47, 61, and 62 are currently amended herein. Amendments to the claims are fully supported by the specification, therefore no new matter is added by these Amendments. Applicants respectfully request reconsideration of the rejected claims in view of the Amendment submitted herein and the following remarks.

**Rejection of Claims 62 Under the Written Description Requirement of 35 U.S.C. § 112, First Paragraph**

Claim 62 was rejected in the September 9, 2003, Office Action under the written description requirement of 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. It is the Examiner's position that, unless the negative limitation "substantially free of fluorine" in Claim 62 is positively recited in the specification, it constitutes new matter. Applicants draw the Examiner's attention to the amendments of Claim 30, 46, 61 and 62 which recite a "non-fluorinated" chromium catalyst.

Respectfully, Applicants request reconsideration of this rejection for the following reasons. For the Examiner's convenience, copies of the cited decisions and Federal Register Notices are attached.

Respectfully, Applicants maintain that these amendments which recite a "non-fluorinated" chromium catalyst find ample support within the specification. While non-

fluorination is not exactly, or *in haec verba*, described in the specification, one of ordinary skill would readily recognize that the claimed catalyst composition polymerizes monomers to polymers when the chromium catalyst is non-fluorinated. Accordingly, Applicants maintain that in this way, the specification at Example 1 (page 22), Example 2 (page 25), and Example 3 (page 29), provides literal support that the chromium catalyst is-a non-fluorinated catalyst.

Applicants respectfully note that these claims are in full compliance with the MPEP. Thus, MPEP 2173.05(i) states that, “a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support.”

The written description requirement of 35 U.S.C. § 112, first paragraph, is set forth in italics as follows:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. (Emphasis added.)*

To test the sufficiency of support to satisfy the written description requirement of an application, as in the present application, “the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed.”<sup>1</sup> Both the Court of Appeals for the Federal Circuit and the PTO have rejected any requirement that the specification have an exact or *in haec verba* description of the claimed

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<sup>1</sup> *Ex Parte Parks*, 30 USPQ2d 1234, 1237 (Bd. Pat. App. & Inter. 1993). See also Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 “Written Description” Requirement, 66 Fed. Reg. 1099, 1104 (Jan. 5, 2001).

invention.<sup>2</sup> Rather, the written description requirement is satisfied by the disclosure of such descriptive means as words, structures, figures, diagrams, formulas, and the like, that fully set forth the claimed invention.<sup>3</sup> Thus, the artisan must reasonably discern the limitation at issue in the claims when reading the original disclosure.<sup>4</sup>

Citing the Board of Patent Appeals and Interferences decision in *Ex Parte Parks*, MPEP 2173.05(i) states that, "a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support."<sup>5</sup> The *Ex Parte Parks* Board found that claims were improperly rejected on ground of inadequate written description under 35 U.S.C. § 112, first paragraph. The Board noted that the originally-filed disclosure need only convey, to one of skill in art, that the applicant had possession of concept of what is claimed in order to satisfy description requirement, since lack of literal basis in disclosure for limitation that decomposition step of claims be "conducted in the absence of a catalyst" thus does not establish *prima facie* case for lack of descriptive support, and since it cannot be held that originally-filed disclosure would not have conveyed concept of effecting decomposition at elevated temperature in absence of catalyst.

Further, the CCPA in *In re Johnson* overturning a written description rejection under 35 U.S.C. § 112, first paragraph, because the applicant amending a claim to proviso out subject matter from the prior art.<sup>6</sup> The *In re Johnson* Court concluded that the examiner's rejection was

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<sup>2</sup> *Crown Ops. Int'l, Ltd. V. Solutia Inc.*, 289 F.3d 1367, 1376 (Fed.Cir. 2002) and Guidelines at 1105. See also *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed.Cir. 1991).

<sup>3</sup> *Crown Ops.*, 289 F.3d at 1376.

<sup>4</sup> *Id.*

<sup>5</sup> *Ex Parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

<sup>6</sup> *In re Johnson*, 558 F.2d 1008, 194 U.S.P.Q. 187 (C.C.P.A. 1977).

nothing more than a "hypertechnical application of legalistic prose" relating to § 112.<sup>7</sup> *In re Driscoll* also stands for the proposition that the Applicants may excise the prior art from a claim and still satisfy the written description requirement of 35 U.S.C. § 112, first paragraph.<sup>8</sup>

Respectfully, Applicants assert that Federal Circuit decisions, including those cited herein, stand for the proposition that a patent Applicant may excise the prior art from the claim and still fully satisfy the written description of 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request this rejection of Claim 62 under 35 U.S.C. § 112, first paragraph, be withdrawn, and this claim be allowed.

**Rejection of Claims 30-47, 61, and 62 Under 35 U.S.C. § 112, Second Paragraph**

Claims 30-47, 61, and 62 were rejected in the September 9, 2003, Office Action under 35 U.S.C. § 112, second paragraph, as being indefinite. It is the Examiner's position that Applicants' Markush language in Claims 30, 39, 46, 61, and 62 renders them indefinite. It is also the Examiner's position that Claims 40, 42, and 44 strictly lack antecedent basis, and that the "a" in the last line of Claim 47 renders it indefinite.

Claims 30-47, 61, and 62. Respectfully, Applicants request reconsideration of the rejection of Claims 30-47, 61, and 62 under 35 U.S.C. § 112, second paragraph, as being indefinite. It is the Examiner's position that Applicants have used improper Markush language in Claims 30, 39, 46, 61, and 62. Note that Claims 61 and 62 are amended herein to replace "and" with "or".

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<sup>7</sup> *Id.* at 1019, 194 U.S.P.Q. at 196; *see also In re Driscoll*, 562 F.2d 1245, 1249, 195 U.S.P.Q. 434, 438 (C.C.P.A. 1977) (another case in which the CCPA criticized the PTO for a "hypertechnical application" of the written description requirement).

<sup>8</sup> *In re Driscoll*, 562 F.2d at 1249, 195 U.S.P.Q. at 438.

Respectfully, Applicants have employed the MPEP-sanctioned alternative Markush terminology when using “or” in these claims. As stated in the MPEP:

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if “wherein R is a material selected from the group consisting of A, B, C and D” is a proper limitation, then “wherein R is A, B, C or D” shall also be considered proper.

MPEP § 2173.05(h)(I). Futher, the MPEP also provides:

Alternative expressions using “or” are acceptable, such as “wherein R is A, B, C, or D.” The following phrases were each held to be acceptable and not in violation of 35 U.S.C. 112, second paragraph in *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975): “made entirely or in part of”; “at least one piece”; and “iron, steel or any other magnetic material.”

MPEP § 2173.05(h)(II).

Accordingly, Applicants respectfully request this rejection of Claims 30-47, 61, and 62 under 35 U.S.C. § 112, second paragraph, be withdrawn, and these claims be allowed.

Claims 40, 42, 44, and 47. Applicants have amended dependent Claims 40, 42, and 44 to reflect a strict antecedent basis in independent Claim 39, from which these claims depend. Applicants have also amended Claim 47 according to the Examiner’s suggestion.

Accordingly, Applicants respectfully request this rejection of Claims 40, 42, 44, and 47 under 35 U.S.C. § 112, second paragraph, be withdrawn, and that Claims 30-47, 61, and 62 be allowed.

**Rejection of Claims 30-45, 61, and 62 Under 35 U.S.C. § 103(a)**

Claims 30-45, 61, and 62 were rejected in the Office Action mailed September 9, 2003, under 35 U.S.C. § 103(a), as unpatentable over U.S. Patent No. 6,245,869 to Debras et al. (“Debras”), in view of either U.S. Patent No. 4,845,176 to Konrad et al. (“Konrad”) or U.S. Patent No. 3,947,433 to Witt (“Witt”), for the reasons stated in the final Office Action dated October 16, 2001. It is the Examiner’s position that Claims 30, 46, and 61 are “open” and do not prohibit the presence of fluorine.

It is also the Examiner’s position that “substantially free of fluorine” recited in Claim 62 is an unavailing attempt to overcome the cited references, because it is new matter. Applicants request reconsideration of this rejection for the following reasons.

Applicants have amended Claims 30, 61, and 62 to recite a “non-fluoridated” chromium catalyst. Respectfully, Applicants submit that Debras does not teach or suggest a chromium catalyst as claimed in Claim 30-45, 61, or 62. Rather, Debras discloses a chromium-based catalyst that is fluorinated and reduced by carbon monoxide. According to Debras, this results in a catalyst containing typically from 0.2 to 2 weight percent fluorine, based on the weight of the chromium-based catalyst (col. 3, lines 20-22). Nowhere does Debras, alone or in combination with Konrad or Witt, suggest that a reduced non-fluorinated chromium-based catalyst can be prepared. Thus, the combination of Debras in addition to Konrad or Witt still does not change the underlying make-up of the fluorinated chromium-based catalysts of Debras in a manner that renders Claim 30-45, 61, or 62 obvious.

Respectfully, Applicants have employed the MPEP-sanctioned alternative Markush terminology using “or” in Claims 30, 39, 61, and 62, as allowed by MPEP § 2173.05(h)(I) and MPEP § 2173.05(h)(II), and as discussed above in detail.

Further, Applicants respectfully state that the negative limitation of Claim 30-45, 61 and 62 does not constitute new matter, as stated by the Federal Circuit, and as discussed above in detail.

Accordingly, Applicants respectfully request this rejection of Claims 30-45, 61, and 62 under 35 U.S.C. § 103(a) be withdrawn, and that these claims be allowed.

**Rejection of Claims 46 and 47 Under 35 U.S.C. § 103(a)**

Claims 46 and 47 were rejected in the Office Action mailed September 9, 2003, under 35 U.S.C. § 103(a), as unpatentable over Debras, in view of either Konrad or Witt, and further in view of Benham, for the reasons stated in the final Office Action dated October 16, 2001. It is the Examiner's position that Applicants' Markush language in Claims 30, 46, and 61 is "open" and does not prohibit the presence of fluorine.

Applicants have amended Claim 46 to recite a "non-fluoridated" chromium catalyst. Respectfully, Applicants submit that Debras does not teach or suggest a chromium catalyst as claimed in Claim 46 and 47. Applicants respectfully submit that Debras, Witt and Konrad, whether combined with Benham or not, do not teach or suggest a dual catalyst composition as claimed in Claim 46 and 47. Rather, Debras discloses a chromium-based catalyst that is fluorinated and reduced by carbon monoxide. According to Debras, this results in a catalyst containing typically from 0.2 to 2 weight percent fluorine, based on the weight of the chromium-based catalyst (col. 3, lines 20-22). Benham fails to remedy the deficiencies of Debras, Konrad, and Witt, either alone or in combination.

Respectfully, Applicants have employed the MPEP-sanctioned alternative Markush terminology using “or” in Claims 46 and 47, as allowed by MPEP § 2173.05(h)(I) and MPEP § 2173.05(h)(II), and as discussed above in detail.

Further, Applicants respectfully state that the negative limitation of Claim 46 does not constitute new matter, as stated by the Federal Circuit, and as discussed above in detail.

Accordingly, Applicants respectfully request this rejection of Claims 46 and 47 under 35 U.S.C. § 103(a) be withdrawn, and that these claims be allowed.

CONCLUSION

The foregoing is submitted as a full and complete Response to the Office Action dated September 9, 2003. For at least the reasons given above, Applicants respectfully submit that Claims 30-47, 61, and 62 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Order Account No. 11-0855.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,



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